

S:N: 10/682,251

Atty Dkt No. GP-303190 (GM0411PUS)

Remarks

Claims 1-3, 5-13 and 15-23 are pending in this Application. Claims 8 and 18 are allowed. Claims 1-3, 7, 9-13 and 19-21 are rejected under 35 U.S.C. § 103(a) as being obvious based on prior art cited by the Examiner. Claims 5, 6, 15, 16, 22 and 23 are objected to as being depending on a rejected base claim, but are allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Examiner has not indicated the status of claim 17.

Objections to the Claims

The Examiner finds claims 5, 6, 15, 16, 22 and 23 to be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims. Accordingly, claim 5 has been rewritten in independent form to include all limitations of previously presented claim 1. Claim 6 has been rewritten in independent form to include all limitations of previously presented claim 1 and original claim 2.

Claim 15 has been rewritten to depend from currently amended claim 5, to delete a now duplicative limitation "wherein said plurality of spray holes comprises a top hole for spraying a piston dome and side holes for spraying a piston skirt," and to add the limitation of claim 2. As amended, claim 15 is commensurate in scope with claim 12 and the previously presented version of claim 15 (i.e., claim 15 has the same scope as it would had it had been rewritten in independent form to incorporate all of the limitations of claim 12). Thus, claim 15 should be allowable.

Claim 16 is cancelled, as it is of the same scope as claim 6.

Claim 22 has been rewritten in independent form to include all of the limitations of previously presented claim 1, and original claims 2 and 3, from which it had previously ultimately depended.

Claim 23 remains as previously presented. Because it depends from currently amended claim 22, it is of a scope indicated by the Examiner to be allowable.

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Rejections Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-3, 7, 9-13, and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over Stearns (United States Patent No. 1,959,279), Papaefthemeou (United States Patent No. 1,945,374), or Vincent (United States Patent No. 1,424,428) in view of Buhl (United States Patent No. 4,142,484).

The Examiner finds that:

Each of the primary references [Stearns, Papaefthemeou and Vincent] show an external tube (28, 44, 52, respectively) for delivering oil from a first end to a second end of a connecting rod. However, there are no plurality of spray holes in the second end. Buhl shows (figure 4) a plurality of spray holes 12a, 12b in the second end of the connecting rod for cooling the piston. It would have been obvious to one of ordinary skill in the art to provide spray holes in the second end of the connecting rods of Stearns (1959279), Papaefthemeou (1945374), or Vincent (1424428) in view of Buhl (4142484) to cool the piston.

Applicant submits that neither Sterns, nor Papaefthemeou nor Vincent provide a suggestion or motivation to provide "a plurality of spray holes formed in the second end [of the connecting rod body] for spraying lubricant received from the tube onto a piston" as required by previously presented independent claim 1, previously presented independent claim 12 and previously presented independent claim 20. Nor do any of Stearns, Papeafthemeou and Vincent provide a suggestion or motivation to

distribut[e] lubricant received from the tube through spray holes formed in the pin bore end of the body for spraying lubricant onto the piston[.] (emphasis added)

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as required by previously presented independent claim 21. Any inference of this teaching from Stearns, Papaefthemou or Vincent is hindsight reasoning based upon the teachings of the present application. The Federal Circuit makes clear that the best defense against the subtle but powerful attraction of impermissible ‘hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.’ In re Dembiczak, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999). See also Graham, 383 U.S. at 18, 148 USPQ at 467 (“strict observance” of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. See, e.g., Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.”).

Accordingly, because the cited references do not provide a suggestion or motivation to provide “a plurality of spray holes formed in the second end [of the connecting rod body] for spraying lubricant” as required by independent claims 1, 12 and 20, the rejection under Section 103(a) of these claims as well as of claims 2-3, 7, 9-11, 13, 17 and 19 which depend therefrom is believed to be improper. Additionally, because the cited references do not provide a suggestion or motivation to “distribut[e] lubricant received from the tube through spray holes formed in the pin bore end of the body for spraying lubricant onto the piston” as required by claim 21, the rejection under Section 103(a) of this claim is believed to be improper.

Conclusion

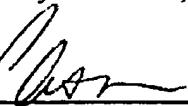
This amendment is believed to be fully responsive to the Office Action mailed November 9, 2004. The remarks in support of the rejected claims are believed to place claims 1-3, 7, 9-13, 17 and 19-21 in condition for allowance, which action is respectfully requested. The amendments to claims 5, 6, 15 and 22 are believed to put these claims, as well as claim 23 which depends from claim 22, in condition for allowance.

Please charge any additional fees due to Deposit Account number 07-0960.

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